

differentiation by antagonizing Notch function,
classified in Class 424, subclass 130.1+.

III. Claims 113-123 drawn to a method of
manipulating cell differentiation by
interfering with toporythmic protein binding,
classified in Class 424, subclass 130.1+.

The Examiner contends that the inventions are
distinct, each from the other.

Further, the Examiner has required an election of
species within each group for prosecution on the merits, to
which the claims shall be restricted if no generic claim is
held to be allowable, as follows:

If Group I is elected, the Examiner has required an
election from among the following species:

- A. methods involving the toporythmic protein Delta
or fragments of the Delta protein (claims 98,
103, 106, 109 and 110);
- B. methods involving Notch protein, fragments, or
analogs (claims 98, 101, 104, 106, 109 and
112); and
- C. methods involving the toporythmic protein
Serrate (claims 98, 105, 106, 109 and 111).

If Group II is elected, the Examiner has required an
election from among the following species:

- A. methods involving Notch protein, fragments, or
analogs (claims 90, 91, 93, 99-101, 104, 107,
108, 109 and 112);
- B. methods involving antibodies to Notch (claims
90, 91, 94-96, 107, 108 and 120-123);
- C. methods involving antibodies to Delta (claims
90, 91, 94, 95, 97, 107 and 120-123);
- D. methods involving antibodies to Serrate (claims
90, 91, 94, 95, 97, 107 and 120-123);
- E. methods involving antisense (claims 90, 91, 102

- and 107); and
- F. methods involving Notch sense DNA (claims 90, 91, 106 and 107).

If Group III is elected, the Examiner has required an election from among the following species:

- A. methods of applying Notch and affecting binding with Notch;
- B. methods of applying Notch and affecting binding with Delta;
- C. methods of applying Notch and affecting binding with Serrate;
- D. methods of applying Delta and affecting binding with Notch;
- E. methods of applying Delta and affecting binding with Delta;
- F. methods of applying Delta and affecting binding with Serrate;
- G. methods of applying Serrate and affecting binding with Notch;
- H. methods of applying Serrate and affecting binding with Delta; and
- I. methods of applying Serrate and affecting binding with Serrate.

Preliminarily, Applicants wish to point out that Applicants believe that the Examiner has made an error in determining that claims 94-96 drawn to antibodies are to be placed only in Group II. The Examiner is partially correct in stating that antibodies to Delta and Serrate can be antagonists. However, claims 94-96 are also directed to antibodies to Notch, which can be inhibiting antibodies (blocking protein-protein interactions) or activating antibodies (mimicking protein-protein interactions). Thus, claims 94-96 should also be included in Group I.

Based on the foregoing, Applicants believe that the division of the claims into the subject matter specified by the Examiner should have been as follows for Group I: Claims

90, 92, 94-96, 98, 101, 103-106 and 109-112.

In order to be fully responsive, Applicants hereby provisionally elect with traverse the invention of Group I, claims 90, 92, 94-98, 101, 103-106 and 109-112, drawn to a method of manipulating cell differentiation by promoting Notch function, classified in Class 424, subclass 130.1+. Further, Applicants provisionally elect with traverse species A of Group I, claims 98, 103, 106, 109 and 110, drawn to methods involving the toporythmic protein Delta.

With respect to the Examiner's division of the invention into three groups and numerous species and the reasons stated therefor, Applicants respectfully traverse. As indicated above, there is substantial overlap between the three groups as to whether the claims encompass methods involving manipulation of cell differentiation by, *inter alia*, antagonism or promotion of Notch function.

Even assuming *arguendo* that Groups I, II and III and the numerous species listed by the Examiner represent distinct or independent inventions, Applicants submit that to search the subject matter of all the Groups together would not be a serious burden on the Examiner.

The M.P.E.P. § 803 (Sixth Edition, Rev. 3, July 1997) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, these three groups should be examined in one application since examining these three groups together would not pose a serious burden for the examiner.

Thus, in view of M.P.E.P. § 803, all of claims 90-123 should be searched and examined in the present application.

Furthermore, even assuming, *arguendo*, that Groups I, II and III constituted distinct related inventions, such inventions should not be divided since these groups are all classified in the same class and subclass, the field of search

would be the same, and there is no indication otherwise. As stated by MPEP § 808.02 (Sixth Edition, Rev. 3, July 1997):

Where, however, the classification is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

Thus, in view of MPEP § 808.02, the restriction requirement, at a minimum, should be modified to combine Groups I, II and III.

Accordingly, Applicants respectfully request that the Restriction Requirement under 35 U.S.C. § 121 be withdrawn, and that the requirement for a species election be withdrawn, and that present claims 90-123 be examined in one application.

Applicants retain the right to petition from the restriction requirement under 47 C.F.R. § 1.144.

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the present application.

Respectfully submitted,

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Enclosures